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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,224	08/31/2000	Robert C. Mayes	10006908-1	4787

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/653,224

Applicant(s)

MAYES, ROBERT C.

Examiner

Tan Dean Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The prior art statement filed 8/31/00 has been received and recorded.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

1. Claims 1-6, 7-9, 12-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

[Bowman US 61 – USPQ 2d, 1669 on 6/12/2001]

2. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

[Bowman US 61 – USPQ 2d, 1669 on 6/12/2001]

3. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea [*A method for manufacturing a single book set (claims 1-6) or books (claims 12-19) or a book on demand system (claims 7-10)*] mere nominal use of a component, albeit within the technological arts, does not confer statutory

subject matter to an otherwise abstract idea if the component does not affect or effect the underlying process.

[State Street Analysis]

Moreover, For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 7-11, 12-19 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Celorio Garrido.

As for claims 1, 7, 12, Celorio Garrido discloses a method for manufacturing a single book or books comprising a) manufacturing the book set and b) having option to select the size of the book at various physical dimensions or sizes such as width, length, and thickness as defined by the customer or according to the customer choice (see col. 7). As for the limitation of “so that the book set can be physically placed or fit

within a storage space, this is inherently included in the process of Celorio Garrido when the customer specifies the desired size in which the customer must think about fitting the book into its normal storage shelf/space when it's not being used.

Alternatively, since it's well known that book is normally placed/stored properly in book shelf or storage, it would have been obvious for the customer to choose the book size that fits properly into the book shelf or storage.

As for claims 2-6, 7-11, 12-19, they are disclosed and/or fairly taught in the method or book order system Celorio Garrido as shown on cols. 1-8, 9-10.

Alternatively, the adjustment of other non-critical elements such as selection of book size, design of cover page, printing formats, text fonts and size, etc., are fairly taught by Celorio Garrido and are within the skill of the artisan as mere desired choice to meet personal needs and would have been obvious.

7. Claims 1–6, 7, 12 are rejected (2nd) under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Financial Times Article.

As for claims 1, 7, 12, Financial Times Article discloses a method and system for manufacturing a single book or books comprising a) manufacturing the book set and b) having option to vary the size and width of the book according to the choice of the (see text). As for the limitation of "so that the book set can be physically placed or fit within a storage space, this is inherently included in the process of Financial Times Article when the customer specifies the desired size in which the customer must think about fitting the book into its normal storage shelf/space when it's not being used. Alternatively, since it's well known that book is normally placed/stored properly in book shelf or

storage, it would have been obvious for the customer to choose the book size that fits properly into the book shelf or storage.

As for claims 2-6, they are disclosed and/or fairly taught in the method or book order system Financial Times Article as shown on pages 1-2. Alternatively, the adjustment of other non-critical elements such as selection of book size, design of cover page, printing formats, etc., are fairly taught by Financial Times Article and are within the skill of the artisan as mere desired choice to meet personal needs and would have been obvious.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 1022541A discloses a process for determination of the geometry of sheet-type materials using image processing and analysis to ensure the reject rate during book production and printing.

WO 99/17934 discloses an electronic bookstore vending machine. It fails to discuss about book size to fit the customer's desired choice.

US patent 5,213,461 discloses a method for rapidly generating personalized books while waiting a purchase order. It fails to include the option of size selection so that the book can be stored within the book storage space.

Article "E-book Economics (electronic books and the publishing industry) discloses the ordering of E-books in certain size, font type, etc. and could have been used as a rejection of claims 1-7, 12 above.

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9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
November 6, 2002


DEAN T. NGUYEN
PRIMARY EXAMINER